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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---------------------------------|-------------|----------------------|---------------------|------------------|
| 09/807,285 | 06/19/2001 | Vincent Wilmet | S-98/24 | 6029 |
| 23416 | 7590 | 06/15/2004 | EXAMINER | |
| CONNOLLY BOVE LODGE & HUTZ, LLP | | | PRICE, ELVIS O | |
| P O BOX 2207 | | | ART UNIT | |
| WILMINGTON, DE 19899 | | | PAPER NUMBER | |

1621

DATE MAILED: 06/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/807,285

Applicant(s)

WILMET ET AL.

Examiner

Elvis O. Price

Art Unit

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-44 is/are pending in the application.
- 4a) Of the above claim(s) 33-44 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11-13 and 22-32 is/are allowed.
- 6) ☒ Claim(s) 14-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 11-44 are present in the application.
2. Applicants' amendments, filed 3/22/04, have overcome the 35 USC 102(b) rejections, issued in the office action dated 10/20/03, for claims 11-17 and 19-21. However, claim 18 remains rejected under 35 USC 102(b) and a new rejection has been issued for claims 14-17 and 19-21.
3. Claims 22-32 have now been prosecuted along with claims 11-21 because applicants have amended claims 22-32 such that they are now dependent on claim 11. However, newly submitted claims 33-44 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The scope of catalyst of claims 33-44 is much larger than that of the catalyst claimed in claims 11-32 since the catalyst of claims 33-44 is not limited to containing ammonium salt (no ammonium may be present). Thus, Prior art anticipating or rendering obvious the invention of claims 11-32 would not necessarily anticipate or render obvious the invention of claims 33-44 or if the invention of claims 11-32 is held to be unobvious would not necessarily render the invention of claims 33-44 unobvious. Thus, an undue burden of search would be required to prosecute the two distinct inventions.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 33-44 have been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 18 is rejected under 35 U.S.C. 102(b) as being anticipated by Nappa et al. {US Pat. 5,475,167}.

Nappa et al. disclose a process for the catalytic hydrofluorination of chlorotetrafluoroethane comprising reacting chlorotetrafluoroethane with hydrogen fluoride, in the gas phase, to produce pentafluoroethane (see abstract and Col. 4, lines 28-49).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 14-17 and 19-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 14 recites the limitation "The Process" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Response to Arguments

Applicant's arguments with respect to claims 14-17 and 19-21 have been considered but are moot in view of the new ground(s) of rejection.

Art Unit: 1621

Allowable Subject Matter

The following is a statement of reasons for the indication of allowable subject matter: The subject matter of claims 11-13 and 22-32 are unobvious over the prior art of record because the prior art of record does not teach or suggest a catalyst based on chromium oxide which contains ammonium salt of less than or equal to 0.2% by weight.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elvis O. Price whose telephone number is 571 272-0644. The examiner can normally be reached on 8:30 am to 5:00 pm; Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter can be reached on 571 272-0646. The fax phone numbers for the organization where this application or proceeding is assigned is 703 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-1235.

A handwritten signature in black ink, appearing to read 'Elvis O. Price', with a stylized flourish at the end.

Elvis O. Price

June 13, 2004